

Application No. 09/748,992

Remarks

The Office Action mailed March 11, 2004 set a period for reply of six months from the mailing date of the Office Action. The Office Action mailed March 11, 2004 rejected claims 1-15 under 35 U.S.C. §102(b), citing U.S. Patent 5,633,932 to Davis et al. The Office Action also rejected claims 4, 7, and 8 under 35 U.S.C. §103(a), also citing U.S. Patent 5,633,932 to Davis et al.

Turning first to applicant's claim 1, the method of printing an electronic document defined in claim 1 is not shown by the Davis et al. reference. The Office Action states that Davis et al. teach that upon transmitting the document to a printing node, the sending node creates a header including disclosure protection information such as "print only" tags. However, the reference does not teach or suggest that in certain circumstances when the document is printed on a print medium, an authentication mark is included. The reference teaches that the printing node decrypts the header to determine whether the document is a "sensitive" document. While Davis et al. describe different techniques of electronic handling of the document depending on whether it is identified as a "sensitive" document, or a normal document, the reference does not show or suggest printing the document with different marks depending on the identification of the document. It is also noted that "authentication" in the Davis et al. reference pertains to confirming that the intended recipient is near the printing node, and does not pertain to authenticating the content of the information in the document.

With respect to dependent claim 3, Davis et al. further do not suggest printing on the printed output a predetermined authentication mark corresponding to the authentication information in the document. The Davis et al. reference describes only printing the contents of the electronic

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document. The analysis applied in the Davis et al. system is only to establish whether and when to print the document, not whether to print a predetermined authentication mark.

In yet a further distinction of the invention as defined in dependent claim 4, Davis et al. do not show or suggest printing different authentication marks on the printed output depending upon whether the confirmation of different authentication information.

The method of printing a document specified in independent claim 9 is also not shown or suggested by the Davis et al. reference. Davis et al. describes determining whether the document is a "sensitive" document or a "normal" document using header information, and then directing the printing node either to print the document or to hold the document in an internal buffer memory to await recipient authentication before printing the document. However, the reference does not suggest printing any different information, such as an authentication mark, on the basis of a verification algorithm authenticating the electronic document. It appears that the printed output from the printing node is no different for a "sensitive" document or a "normal" document. The analysis applied in the Davis et al. system is only to establish whether and when to print the document, not whether to print a particular authentication mark based on the results of a verification algorithm to authenticate the electronic document.

Dependent claim 10 amplifies the distinction between applicant's invention and the electronic document processing described in the Davis et al. reference. In dependent claim 10, the method includes automatically printing the document with a first authentication mark if the step of applying the first verification algorithm authenticates the electronic documents, and automatically printing the document with a second authentication mark if the step of applying the second verification algorithm authenticates the electronic

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document. Davis et al. do not suggest printing the printed output with different authentication marks or different content based on the results of the authentication information or release code.

With respect to the document printer of the present invention as defined in independent claim 12, the Davis et al. reference does not indicate any apparatus for applying, in addition to the image of the electronic document, a visible authenticity mark if the printing node confirms the authentication information or release code. The analysis applied in the reference is to establish whether and when to print the document, and does not describe printing an authenticity mark based on the result of authenticity verification.

With further respect to dependent claim 15, Davis et al. do not suggest a system that confirms whether an electronic document contains either a first or second set of authenticity information, and then applies to the print media different authenticity marks depending on whether the electronic document contains the first or second set of authenticity information.

Claims 4, 7, and 8 were additionally rejected under 35 U.S.C. §103(a), citing U.S. Patent 5,633,932 to Davis et al. The Office Action states that it would have been easy to authenticate the sending node by matching its transmitted signature with that in storage. Applicant respectfully submits that, just because following applicant's suggestion of a function would be "easy" does not render the suggestion of the function obvious to a person of ordinary skill in the art. Furthermore, even if verifying different sending nodes using unique encrypted signatures would have been obvious, Davis et al. do not suggest printing different authentication marks on the printed output depending upon the authentication information confirmed in the electronic document. Therefore, applicant's invention as defined in claim 4 would not have been obvious in view of the Davis et al. reference.

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With further reference to dependent claim 8, Davis et al. do not suggest a method in which different authenticity marks are printed on the printed document depending on the results of a comparison function. The comparison functions in the Davis et al. reference appear to pertain exclusively to the control of the printing process, and it is not apparent from the reference that different printed outputs are produced.

Applicant has added new dependent claims 17-19, which depend from claim 1, to further distinguish aspects of applicant's invention from the method described in the Davis et al. reference. Applicant has also added dependent claims 20-22, which depend from claim 13, to further specify aspects of the document printer that are not shown or suggested by the Davis et al. reference.


Applicant therefore submits that claims 1, 3-13, 15-22 define applicant's invention so as to be patentably distinct from the cited reference, and therefore respectfully requests allowance of claims 1, 3-13, 15-22.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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If the Examiner considers personal contact helpful to dispose of this case, call David J. Arthur, at Telephone Number (585)423-9215, Rochester, New York.

Respectfully submitted,



David J. Arthur
Attorney for Applicant(s)
Registration No. 30,707
(585) 423-9215

DJA/cw

Xerox Corporation
Xerox Square 20A
Rochester, New York 14644